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09/820,562	03/29/2001	Gilbert Bloch	82017-3700	4962

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WINSTON & STRAWN  
200 Park Avenue  
New York, NY 10166-4193

EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 07/18/2002

4

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-15 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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1. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicants regard as their invention.

2. Claims 7 and 8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, in each of these claims, proper Markush language should be substituted for "includes".

3. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-15 are rejected under 35 U.S.C. § 112, first paragraph, as based on a disclosure which is not enabling. More particularly, applicants' specification appears to teach (note, e.g. specification, page 2, lines 27-32) that the plastic film ply is "oriented" and also "cold laminated" to the accompanying paper film appears to be critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by

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the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Note also that the interview in parent case Serial No. 09/258,766, U.S. Patent 6,235,386 appears to have taught that these parameters are critical elements of the invention and accordingly should each be incorporated into the independent claim.

5. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Williams -877 or Williams -971, each taken in view of Ohno et al. The primary references, the first of which is discussed on pages 1 and 2 of the specification, each appears to disclose (note particularly Williams -877, the Abstract, column 3 lines 10-38, column 3 line 44 - column 4 line 2; Williams -971, column 1 lines 16-22, column 1 lines 55-63, column 3 lines 20-30, column 3 lines 37-54) substantial anticipations of at least applicants' broad claim except for the absence of a corona discharge treated plastic

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layer which treated surface bonds to the paper layer, as well as a pressure sensitive adhesive which meets the criteria set forth in the last three lines of claim 1 that permit the film to be stripped in one piece from the item to which it is adhered to. However, although there appears to be some evidence that Williams -877 (and perhaps Williams -971 as well) may delaminate during usage, neither of the references appears to teach such behavior is necessarily present. That is, each of the references teaches an oriented polyolefin film such as polypropylene or polyethylene that is laminated by use of a suitable laminating adhesive to the paper carrier layer, which resultant layer is then coated on an outer surface with a suitable pressure sensitive adhesive. With respect to the absence of a corona discharge treated surface plastic layer or adhesives which meet the requirements of those species set forth in applicants' claim 8, note that the secondary reference, which is also taken from the multilayer adhesive tape art discloses (note particularly column 3, lines 1-21) a broad genus of pressure sensitive adhesives which are based upon either natural or synthetic rubber, such as those compositions applicants contemplate and which would inherently permit the behavior set forth in the bottom three lines of applicants' independent claim. Additionally, the reference further teaches in the same section the utilization of corona discharge treatment to improve the adhesive strength between various layers, which

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the Examiner also strongly believes has been well known in the adhesive tape art for some time. Accordingly, one of ordinary skill, motivated by the desire to eliminate the problem of delamination and allow the film to be stripped in one piece from a desired substrate would look to the closely related secondary art and incorporate the pressure sensitive adhesive compositions and accompanying corona discharge treatment taught therein in order to form the claimed genus of tapes. With respect to the dependent claims, such elements as the presence of a suitable release agent (claims 2 and 3) or desired thicknesses (claim 4) are each believed well known to one of ordinary skill. Additionally, note also that "cold laminated" which at the present time is a product-by-process limitation not shown to produce a patentably distinct article, has also been known for some time. Evidence of this, e.g. can be noted in a prior patent of two of the applicants, e.g. Finestone et al., U.S. 5,244,702 (note particularly the Abstract, column 3 lines 9-14, column 3 lines 33-38) and note also that GB 1,569,447 teaches (note particularly page 1, lines 26-44, lines 71-86, page 2 lines 2-10, page 2 lines 45-54) that such backings made from Kraft paper and polyethylene or polypropylene films can be routinely laminated together with conventional adhesives that are well known in the art.

7. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially

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created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,235,386B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only apparent significant difference between the independent claims of the patent versus those which applicants set forth are the utilization of adhesive cold laminating of the paper and plastic layers, which the Examiner believes to be a well known treatment to one of ordinary skill in the art.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also Korpman and Peer, Jr.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

July 9, 2002

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1900-

1700

*Daniel Zirker*